

Remarks/Arguments

Reconsideration of the above-identified application in view of the present amendment and the following remarks is respectfully requested. By the present amendment, claims 1, 5, 8, 13, and 15 have been amended, and claims 6 and 14 have been cancelled.

Preliminary Matters

The Applicant's Representative wishes to thank the Examiner for the courtesies extended during the telephone interview of February 3, 2009. Proposed claim language was discussed during the interview although no agreement was reached.

Claim Rejections – 35 U.S.C. §102

Claims 1-4, 6, 8-12, and 14 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,507,800 to Strickland (hereafter "Strickland"). Claims 6 and 14 have been cancelled, thus rendering the rejection of claims 6 and 14 moot.

As amended, claim 1 recites an apparatus for cutting bone. The apparatus includes a cutting blade adapted to cut through bone and extending in a first plane between a shield section and a guide section. The guide section includes an enlarged substantially sphere shaped terminal end. Support for this subject matter can be found in Figs. 1-2 of the originally filed application and, thus, it is believed that the added subject matter does not constitute new matter. Figs. 1-2 illustrate that the guide section is rounded in two orthogonal planes relative to the axis 14 and, thus, constitutes a substantially spherical end. It is respectfully submitted that Strickland

does not disclose a guide section including an enlarged substantially sphere shaped terminal end, as recited in amended claim 1.

Strickland discloses an improved carpal tunnel tome for performing carpal tunnel release surgery. The tome has a slender handle 11 with a blade 13 at one end. In a first embodiment disclosed by Strickland, the blade 13 is bounded on both sides by a pair of relatively blunt protuberances 17, 18 that extend distally beyond the cutting edge of the blade. Strickland discloses a second embodiment having a blunt protuberance 57 with a thickened, blunted tip portion 57a and a rounded distal end 59. Unlike the apparatus for cutting bone recited in claim 1, the blunt protuberances disclosed by Strickland do not include an enlarged substantially sphere shaped terminal end. Rather, the blunt protuberances disclosed by Strickland are substantially parallelepiped shaped (see Fig. 1-3 and Column 3, lines 58-62). Although the blunt protuberances are provided with rounded distal ends, the rounded portion of the blunt protuberance exists only on a single face of the blunt protuberance. Therefore, the blunt protuberances are still substantially parallelepiped shaped. The substantially parallelepiped shaped blunt protuberances clearly do not have an enlarged substantially sphere shaped terminal end, as recited in amended claim 1. The thickened, blunted tip portion disclosed in the second embodiment is also substantially parallelepiped shaped, and clearly does not have an enlarged substantially sphere shaped terminal end, as recited in amended claim 1. Accordingly, it is respectfully requested that claim 1 be allowed.

Claims 2-4 depend from claim 1 and are allowable for at least the same reasons as claim 1 and for the specific limitations recited therein. Accordingly, it is respectfully requested that claims 2-4 be allowed.

As amended, claim 8 recites an apparatus for cutting through the cortical bone of a vertebral body. The apparatus has an arcuate cutting blade extending in a first plane between first and second tip portions. The second tip portion comprises a blunt tooth extending generally parallel to a cutting axis having an enlarged substantially sphere shaped terminal end. It is respectfully submitted that Strickland does not disclose a second tip portion having an enlarged substantially sphere shaped terminal end, as recited in amended claim 8. As discussed in detail above with regards to claim 1, Strickland discloses an improved carpal tunnel tome having substantially parallelepiped shaped blunt protuberances. Neither the substantially parallelepiped shaped blunt protuberances disclosed in the first embodiment, nor the substantially parallelepiped shaped thickened, blunted tip portion disclosed in the second embodiment have an enlarged substantially sphere shaped terminal end, as recited in amended claim 8. Accordingly, it is respectfully requested that claim 8 be allowed.

Claims 9-12 depend from claim 8 and are allowable for at least the same reasons as claim 8 and for the specific limitations recited therein. Accordingly, it is respectfully requested that claims 9-12 be allowed.

Claim Rejections – 35 U.S.C. §103

Claims 5, 7, 13, and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Strickland in view of U.S. Patent No. 117, 588 to Woods (hereafter "Woods"). Claim 7 depends from claim 1, discussed above, and is allowable for the same reasons as claim 1 and for the specific limitations recited therein. Accordingly, it is respectfully requested that claim 7 be allowed.

35 U.S.C. § 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that analysis supporting a rejection under 35 U.S.C. §103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441, F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

As amended, claim 5 recites the apparatus of claim 1, wherein the guide section is substantially narrower in width than the inwardly facing shield surface of

the shield portion. Support for this subject matter can be found in Fig. 1 of the originally filed application and, thus, it is believed that the added subject matter does not constitute new matter. In addition to its dependency from claim 1, amended claim 5 further is allowable because the combined teachings of Strickland and Woods do not teach or suggest all the features recited in amended claim 5. In particular neither Strickland nor Woods teach or suggest an apparatus having a guide section substantially narrower in width than an inwardly facing shield surface of a shield portion.

Woods discloses a tool for ripping seams sewed in cloth. The tool has a guide (b) and a guard (c). Figs. 1-3 show that the guard is wider than the guide only along the outwardly facing lateral surface of the tool. On the other hand, since the guide and the guard have the same thickness (Fig. 1), the surfaces of the guide and the guard that face inward towards the blade have the same width. The lateral surface of either the guide or the guard clearly has a substantially wider width than the width of these inwardly facing surfaces. This is unlike the apparatus recited in amended claim 5, as the guide section of the apparatus recited in amended claim 5 is substantially narrower in width than the inwardly facing shield surface of the shield portion. For these reasons, it is respectfully requested that amended claim 5 be allowed.

As amended, claim 13 recites the apparatus of claim 8 wherein the second tip portion is substantially narrower in width than the shield surface of the first tip portion. Claim 8 recites that the shield surface extends in a second plane that is transverse to a first plane of the cutting blade. In addition to its dependency from

claim 8, amended claim 13 further is allowable because the combined teachings of Strickland and Woods do not teach or suggest all the features recited in amended claim 13. In particular, neither Strickland nor Woods teach or suggest an apparatus having a second tip portion that is substantially narrower in width than a shield surface of a first tip portion. As stated above, the lateral, outwardly facing surface of the guard of Woods is only wider than the lateral, outwardly facing surface of guide, i.e. wider only along the same plane. This is unlike the apparatus recited in amended claim 13, as the shield surface of the apparatus recited in amended claim 13 is wider in a second plane that is transverse to a first plane of the cutting blade. For these reasons, it is respectfully requested that amended claim 13 be allowed.

As amended, claim 15 recites an apparatus for cutting bone. The apparatus has a guide section that is substantially narrower in width than an inwardly facing shield surface of a shield section. The guide section projects axially beyond the shield section. The Office Action acknowledges that Strickland does not disclose a guide section that projects axially beyond a shield section, as recited in claim 15. The Office Action asserts, however, that Woods cures this deficiency of Strickland, and further asserts that it would have been obvious to combine the teachings of Strickland and Woods.

It is respectfully submitted that the 35 U.S.C. §103 rejection of claim 15 is improper because the Office Action fails to establish *prima facie* obviousness. The rejection of claim 15 under 35 U.S.C. §103 is not supported by any explicit analysis nor any articulated reasoning with some rational underpinning. Rather, the Office

Action only provides a conclusory statement that does not possess any explicit analysis or articulated reasoning as to why it would have been obvious to modify the device of Strickland as taught by Woods. The Office Action merely repeats features present in the Woods device, as recognized by the Office Action (see Office Action page 4, paragraphs 3 and 4). Because the Office Action has not produced a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness.

Although a *prima facie* obviousness case has not been made, it is additionally respectfully submitted that amended claim 15 is allowable because the combined teachings of Strickland and Woods do not teach or suggest all the features recited in amended claim 15. In particular, neither Strickland nor Woods teaches or suggests an apparatus having a guide section that is substantially narrower in width than an inwardly facing shield surface of a shield section. As discussed in detail above with regards to claim 5, the guard disclosed in Woods is wider than the guide only along the outwardly facing lateral surface of the tool and is substantially greater in width than the inwardly facing surface of the guide. This is unlike the apparatus recited in amended claim 15, as the guide section of the apparatus recited in amended claim 15 is substantially narrower in width than the inwardly facing shield surface of the shield portion. For these reasons, it is respectfully requested that claim 15 be allowed.

Conclusion

In view of the foregoing, it is respectfully submitted that the above-identified application is in condition for allowance, and allowance of the above-identified application is respectfully requested.

Please charge any deficiency or credit any overpayment in fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

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